#13
12/20/99

XA-7889A Re

PATENT APPLICATION

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re the Application of:

Kenji NISHI

Appln. No.: 08/994,758 Group Art Unit: 2851

Filed: December 19, 1997 Examiner: A Mathews

For: PROJECTION EXPOSURE APPARATUS

* * *

RESPONSE

Assistant Commissioner for Patents
Washington, D.C. 20231

Sir:

The Office Action mailed November 10, 1999 requires that Applicant comply with 37 C.F.R. §1.607(a)(2-5). The Office Action alleges that:

(A) Applicant has failed to set forth a proposed count and identify at least one claim in U.S. Patent No. 5,796,469 corresponding to the proposed count pursuant to 37 C.F.R. § 1.607(a)(2-3);

(B) Applicant has failed to set forth at least one claim corresponding to the proposed count or identify at least one claim already pending in the application that corresponds to the proposed count pursuant to 37 C.F.R. § 1.607(a)(4); and

(C) Applicant has failed to specifically apply each limitation or element of each of the copied claim(s) to the disclosure of the application pursuant to 37 C.F.R. § 1.607(a)(5).

As pointed out in the Supplemental Amendment filed July 26, 1999, Claims 143-168 were presented to preserve Applicant's rights with respect to a possible interference with Patent No., 5,796,469. When those claims were presented, Applicant did not then request the declaration of an interference because Applicant was unable to obtain the file histories of the '469 patent and its two predecessor applications. These files were declared "lost" by the Patent and Trademark Office, and an official search for the files failed to locate them.

Normally, before an Applicant copies claims from a patent and takes steps to provoke an interference with the patent, the Applicant obtains the file histories of the patent and any predecessor applications, so that in choosing an appropriate proposed count and in designating claims corresponding to the count, the Applicant may obtain some guidance from the prosecution history of the patent and any predecessor applications. For example, it is important to determine in advance of an interference whether the patentee relied on the benefit of any earlier U.S. or foreign patent application under 35 U.S.C. §§ 120 or 119 in order to overcome a rejection, to determine how the patentee distinguished his claims from prior art, and to determine

how the patentee and the Office may have interpreted recitations in the claims.

In the present case, Applicant has not had the benefit of any knowledge that might be obtained from the prosecution history of the '469 patent and its predecessor applications. Moreover, in an Office Action mailed January 25, 1999, certain claims of the present reissue application, including even original patent Claims 9 and 33, were rejected on a Japanese document under 35 U.S.C. § 102(b). Applicant responded to that rejection in an Amendment filed July 26, 1999 but has not yet had the benefit of the Examiner's views regarding the patentability of Claims 9 and 33 as amended.

It is believed that the subject matter of Claims 9 and 33 is relevant to the subject matter of the claims of the '469 patent, and it appears that Applicant's original patent (5,477,304) was not cited as prior art against the '469 patent even though that patent was granted well before the filing of the application underlying the '469 patent, and Applicant's patent has an effective U.S. filing date under 35 U.S.C. § 120 that is earlier than the effective filing date of the '469 patent under 35 U.S.C. § 120.

Under the foregoing circumstances, it may be considered premature to declare an interference. Nevertheless, Applicant is obliged to respond to the Office Action mailed November 10, 1999 and will do so hereinafter:

A

Applicant proposes the following count:

Count 1

An exposure apparatus in which a portion of a pattern of an original is projected onto a substrate and in which the original and the substrate are scanned synchronously such that the pattern of the original is transferred to the substrate, said apparatus comprising:

first and second stages, one of which is for scanningly moving the original and the other of which is for scanningly moving the substrate;

measuring means for measuring a deviation of said first stage relative to said second stage in a predetermined direction other than the direction of scanning movement; and

adjusting means for adjusting the second stage on the basis of the measurement by said measuring means.

Claim 1 of the '469 patent corresponds exactly to the proposed count.

B

Claim 143 of the present reissue application corresponds exactly to the proposed count.

C

The terms of Claim 143 are applied to the disclosure of this reissue application in the following table A:

TABLE A

Claim 143	Disclosure
An exposure apparatus in which a portion of a pattern of an original is projected onto a substrate and in which the original and the substrate are scanned synchronously such that the pattern of the original is transferred to the substrate, said apparatus comprising:	col. 1, lines 9-13; col. 4, line 36 to col. 5, line 29; col. 8, lines 53-55
first and second stages, one of which is for scanningly moving the original and the other of which is for scanningly moving the substrate;	col. 8, lines 27 and 58 (stages 21 and 27) see 8
measuring means for measuring a deviation of said first stage relative to said second stage in a predetermined direction other than the direction of scanning movement;	col. 8 lines 39-52; col. 9, lines 1-11
adjusting means for adjusting the second stage on the basis of the measurement by said measuring means	col. 11, line 61 to col. 12, line 18; col. 12, line 60 to col. 13, line 6 and lines 28-37

With regard to Count 1, Applicant is entitled to the benefit under 35 U.S.C. § 120, of parent application Serial No. 139,803 filed October 22, 1993 as shown in the following Table B:

Table B

Count 1	Serial No. 139,803
An exposure apparatus in which a portion of a pattern of an original is projected onto a substrate and in which the original and the substrate are scanned synchronously such that the pattern of the original is transferred to the substrate, said apparatus comprising:	page 1, lines 5-10; page 10, line 11 to page 12, line 26; page 20, line 16, and page 21, line 23
first and second stages, one of which is for scanningly moving the original and the other of which is for scanningly moving the substrate;	col. 8, lines 27 and 58 (stages 21 and ~~24~~ 28.)
measuring means for measuring a deviation of said first stage relative to said second stage in a predetermined direction other than the direction of scanning movement;	page 21, lines 4-17; and page 22, lines 8-20
adjusting means for adjusting the second stage on the basis of the measurement by said measuring means	page 30, line 14 to page 31, line 13; page 33, lines 4-18; page 34, line 18 to page 35, line 2

sec failed 2 and p14

Filed herewith are certified English translations of Applicant's Japanese priority applications 4-284371 and 4-289985.

With regard to Count 1, Applicant is entitled to the benefit, under 35 U.S.C. § 119, of Japanese application No. 4-289985 filed October 28, 1992 as shown in the following Table C (referring to the English translation):

TABLE C 4-259985

Count 1	JP 4-289~~285~~
An exposure apparatus in which a portion of a pattern of an original is projected onto a substrate and in which the original and the substrate are scanned synchronously such that the pattern of the original is transferred to the substrate, said apparatus comprising:	page 3 [Claim 1]
first and second stages, one of which is for scanningly moving the original and the other of which is for scanningly moving the substrate;	page 8 [0017]; page 9 [0019], second paragraph
measuring means for measuring a deviation of said first stage relative to said second stage in a predetermined direction other than the direction of scanning movement;	pages 8-9 [0018]; page 9 [0020]
adjusting means for adjusting the second stage on the basis of the measurement by said measuring means	page 13 [0032]

Item C of the Office Action refers to "each of the copied claim(s)." However, 37 C.F.R. § 1.607(a)(5) only requires that Applicant apply "the terms of any application claim

(i) Identified as corresponding to the count and

(ii) Not previously in the application to the disclosure of the application."

Since, for the present, Applicant has only identified Claim 143 as corresponding to the proposed count, Applicant

is only obliged under § 1.607 to apply the terms of that claim to the disclosure of the application, and Applicant has done so. Were it not for the circumstances set forth earlier in this Response, Applicant's attorneys would have preferred to provide more detailed information as to claims deemed to correspond to the proposed count and claims deemed not to correspond to the proposed count, and more detailed information as to the manner in which Claims 144-168 are supported by Applicant's disclosure. It is noted, however, that support for Claims 143-168 was stated on page 12 of the Supplemental Amendment filed August 18, 1999.

It is understood, from a telephone call to the Office, that the attorneys responsible for the '469 patent have been requested by the Office to provide reconstructed files of the '469 patent and its predecessor applications. Applicant respectfully requests that the Office promptly notify the undersigned when these files have been reconstructed, so copies can be promptly obtained, hopefully before an interference is declared. After obtaining the copies, Applicant may wish to supplement this Response.

The Commissioner is hereby authorized to charge to Deposit Account No. 22-0585 any fees under 37 C.F.R. §§ 1.16 and 1.17 that may be required by this paper and to credit any overpayment to that Account. If any extension of time is required in connection with the filing of this paper and

has not been requested separately, such extension is hereby requested.

Respectfully submitted,

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NHS:lmb

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